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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/991,679	11/26/2001	Steven Parker	WH 11 264-1US	4166
24962	7590	07/12/2006	EXAMINER	
DENNISON ASSOCIATES 133 RICHMOND STREET WEST SUITE 301 TORONTO, ON M5H 2L7 CANADA			PAULA, CESAR B	
			ART UNIT	PAPER NUMBER
			2178	
DATE MAILED: 07/12/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/991,679	Applicant(s) PARKER ET AL.	
	Examiner CESAR B. PAULA	Art Unit 2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 26,27,30,32,33 and 35-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 26-27, 30, 32-33, and 35-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to the amendment filed on 4/20/2006.

This action is made Final.

2. In the amendment, claims 28-29, 31, 34, and 38 have been canceled. Claims 26-27, 30, 32-33, and 35-37 are pending in the case. Claims 26, and 33 are independent claims.
3. The rejections of claims 26-27, 32-33, and 38 rejected under 35 U.S.C. 102(e) as being anticipated by Gropper (Pat.# 6,883,000, 4/19/2005, filed on 2/12/1999), have been withdrawn as necessitated by the amendment.

Priority

4. It is noted, that applicant has not filed certified copies of the Canadian application number 2,351,780 as required by 35 U.S.C. 119(b). Therefore, the priority claim has been denied.

Drawings

5. The drawings filed on 11/26/2001 have been approved by the examiner.

Claim Objections

6. The objections to claims 32-33 have been withdrawn in light of the amendment.

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7. Claim 30 is objected to because of the following informalities: The claim depends on canceled claim 29. Appropriate correction is required.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claim 30 remains rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

10. Claim 30 still recites the limitation "said account specific business information" in line 2. There is insufficient antecedent basis for this limitation in the claim. There is no previous "account specific business information" in this claim or base claim 29 to refer to.

11. The rejection of claim 31 has been withdrawn as necessitated by its cancellation.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to

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a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 26-27, and 32-33 are, and 30, and 35-36 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Gropper (Pat.# 6,883,000, 4/19/2005, filed on 2/12/1999), in view of Endo et al, hereinafter Endo (USPub. # 2002/0022989, filed on 2/21/2002, filed on 2/22/2002).

Regarding independent claim 26, Gropper discloses a business subscriber conveying business card contact, and advertising information to a server over a public network, such as the Internet. The information includes data such as name, company logo, ads, business card recipient contact information, location etc.-- *a web server, said web server including an arrangement for establishing separate accounts for business; means for uploading and storing on said web server for future account usage account specific business information including graphic images, specific text messages, marketing communications associated with wares or services of the business, and identification of clients including identification and postal address contact personalized printed business browser over the internet information*--(col.3, lines 40-col.4, lines 1-67, col.13, lines 51-67, fig.2-D, fig.3,15).

Moreover, Gropper discloses allowing users to access the business information using passwords-- *said web server further including means for establishing for each account authorized users of the specific account*--(col.8, lines 1-35).

Moreover, Gropper discloses the use of the information for printing a two-sided business card having the business information, which also includes a personal expression—"We make banking simple again--", found on the server-- *said web server including a browser based business communication card preparation procedure for any authorized user of a specific*

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account, said procedure including the authorized user preparing a personalized business communication card having specific panels by selecting account specific business information for specific panels of the personalized business communication based on the uploaded and stored account specific business information in combination with a personal expression entered by the authorized user --(col.35 lines 21-col.36, line 29, fig.2-D, fig.15).

Moreover, Gropper discloses users access the business information located in the server—"We make banking simple again"--, found on the server-- *said preparation procedure further including user specified clients to receive the personalized business communication from the identified clients associated with the specific account and a user executed step to complete the prepared personalized business communication --(col.8 lines 1-35, col.11, lines 1-34, fig.2-D, fig.15).* Gropper fails to explicitly disclose: *communication card having at least three panels, wherein said three panel printed business communication card includes a front surface and a rear surface and wherein one of said surfaces is an exposed address surface receiving said client postal address contact.* However, Endo teaches sending a coupon attached, in the lower half of the back portion of the card which has two sides, each side having two divisions—*panels*—split down the middle of the card, to the greeting card for a free trial of a new song. One panel in the front side contains the postal address of the client that is to receive the card (0054, and 0137, 0141-0144, fig.26-28). It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine Gropper, and Endo, because Endo teaches the benefit of improving the publication effect of businesses, while providing greeting cards at no cost to a sender (0005-0006).

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Furthermore, Gropper discloses users access the business information located in the server, and print the business cards (col.11, lines 1-34, col.35 lines 16-43, fig.15). In other words, the card information is printed and delivered from the server to the printer-- *said web server cooperating with a printing and delivery arrangement to print and deliver the printed personalized business communication to the specified clients*. Gropper fails to explicitly disclose: *specified clients to receive by mail the printed personalized business communication*. However, Endo teaches sending a post office address for the recipient of the coupon, which is located in the upper half of the front of the card (0054, and 0137, 0141-0144, fig.27). It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine Gropper, and Endo, because Endo teaches the benefit of improving the publication effect of businesses, while providing greeting cards at no cost to a sender (0005-0006).

Regarding claim 27, which depends on claim 26, Gropper discloses an event log file for tracking the performance of the client computer (col.25, lines 1-12).

Regarding claim 30, which depends on claim 29, Gropper discloses a UCL, which is conveyed to a recipient via various communication means (col.10, lines 57-67). Gropper fails to explicitly disclose: *four of said account specific business information*. However, Endo teaches the card having information regarding a music ad on all of 4 panels (0054, and 0137, 0141-0144, fig.27). It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine Gropper, and Endo, because Endo teaches the benefit of improving the

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publication effect of businesses, while providing greeting cards at no cost to a sender (0005-0006).

Regarding claim 32, which depends on claim 26, Gropper discloses storing an UCL--*signature*, which can be an email address, along with the card information on the server. The UCL is printed of the card, and can be used for accessing the information stored on the server (col.4, lines 43-67).

Claim 33 is directed towards a method for implementing the system found in claim 26, and therefore is similarly rejected.

Regarding claim 35, which depends on claim 33, Gropper discloses users access the business information located in the server—"We make banking simple again"--, *one of said front and rear surfaces of said panels is designated to receive said personal expression* --(col.8 lines 1-35, col.11, lines 1-34, fig.2-D, fig.15). Gropper fails to explicitly disclose: *one of said front and rear surfaces of said panels is designated to receive said client contact information to effect delivery of the printed business card*. However, Endo teaches sending an address for the recipient of the coupon, which is located in the upper half of the front of the card (0054, and 0137, 0141-0144, fig.27). It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine Gropper, and Endo, because Endo teaches the benefit of improving the publication effect of businesses, while providing greeting cards at no cost to a sender (0005-0006).

Claim 36 is directed towards a method for implementing the system found in claim 27, and therefore is similarly rejected.

14. Claim 37 remains rejected under 35 U.S.C. 103(a) as being unpatentable over Gropper, in view of Tackbary et al, hereinafter Tackbary (USPat.# 6,873,971 B1, 3/29/2005, filed on 3/15/2000)

Regarding claim 37, which depends on claim 33, Gropper discloses placing personal statement, such as the motto "We make banking simple again" only on the front side of the card--(col.8 lines 1-35, col.11, lines 1-34, fig.2-D, fig.15). Gropper fails to explicitly disclose: *displaying on said web server a representation of the business communication as a user selects said business information and enters said personal expression.* However, Tackbary teaches the customization of the image of a card being displayed, by adding a message (col.11, lines 57-67, fig.8-9). It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine Gropper, and Tackbary, because Tackbary teaches above customizing cards to be sent to a user as the image of the card is being displayed (0005-0006). This would provide the benefit of quickly, and effectively modify the card in a WYSIWYG environment with minimal waste of time.

Response to Arguments

15. Applicant's arguments with respect to claims 26-27, 30, 32-33, and 35-37 have been considered but are not persuasive. The Applicant submits that the present invention does not

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require any coordination on the part of the end recipient (pages 9-14). It appears that the Applicant acknowledges that Gropper, and Endo teach the limitations of the claims, but that the references include extra steps not required by the claims. By Applicant's admission, the claims are not novel or non-obvious in light of the relied upon prior art.

Conclusion

16. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

I. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cesar B. Paula whose telephone number is (571) 272-4128. The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 4:00 p.m. (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong, can be reached on (571) 272-4124. However, in such a case, please allow at least one business day.

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Information regarding the status of an application may be obtained from the Patent Application Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, go to <http://portal.uspto.gov/external/portal/pair>. Should you have any questions about access to the Private PAIR system, please contact the Electronic Business Center (EBC) at 866 217-9197 (toll-free).

Any response to this Action should be mailed to:
Commissioner for Patents
P.O. Box 1450

Alexandria, VA 22313-1450

Or faxed to:

- (571)-273-8300 (for all Formal communications intended for entry)


CESAR PAULA
PRIMARY EXAMINER
7/6/06